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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/249,689 05/26/94 SCHIMMEL

P MIT5261

18N2/0417

BRUSCA, EXAMINER

PATREA L. PABST
ARNALL GOLDEN & GREGORY
2800 ONE ATLANTIC CENTER
1201 WEST PEACHTREE STREET
ATLANTA, GA 30309

ART UNIT	PAPER NUMBER
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1805

DATE MAILED:

04/17/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/249,689

Applicant(s)

Schimmel

Examiner

John S. Brusca

Group Art Unit

1805



☒ Responsive to communication(s) filed on 1/2/96

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 3-21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 3-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1805

1. The Amendment and Response to Office Action filed 1/2/96 has been entered.
2. The rejection in Paper No. 28 of claims 1-10 and 14-16 under 35 U.S.C. § 112, second paragraph has been withdrawn in view of the amendment filed 1/2/96.
3. Claims 1 and 3-19 and newly added claims 20 and 21 are rejected under 35 U.S.C. § 112, first paragraph for reasons of record in Paper No. 28.
4. Applicant's arguments filed 1/2/96 have been fully considered but they are not deemed to be persuasive.

The Applicants appear to argue that the rejection of the claims in Paper No. 28 under 35 U.S.C. § 112, first paragraph states a requirement of a working example to enable the claimed invention. However, the rejection does not make such a requirement. Eight factors that may properly be considered in demonstrating the existence of undue experimentation to practice the claimed invention were considered. In view of the lack of guidance or examples to practice the claimed invention, and further in view of the lack of prior art teaching how to perform the specific steps and the specific products of the claimed invention, it was concluded that it would require undue experimentation to practice the claimed invention. The Applicants argue on Page 15 of their response filed 1/2/96 that the absence of the claimed compounds or the claimed methods of producing the claimed compounds in the prior or later art cannot be used as evidence that it would require undue experimentation to practice the claimed invention. However, the absence of success by others in practicing the claimed invention places a greater burden on the Applicants to show how to make and use the claimed

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invention. The citation of Wilson et al. shows clearly that in 1993, three years after the priority date of the instant application, a person of ordinary skill in the art was unable to practice the claimed invention. The prior art incorporated in the Amendment filed 1/2/96 describes in general terms known molecular modeling procedures. Such information merely provides and invitation to experiment to develop the claimed compounds, and does not teach the claimed invention. In the absence of any evidence in the prior art or the specification that the claimed methods can be practiced and that the claimed compounds can be produced, it would require undue experimentation to practice the claimed invention.

5. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Certain papers related to this application may be submitted to Art Unit 1805 by facsimile transmission. The FAX number is (703) 308-0294. The faxing of such papers must

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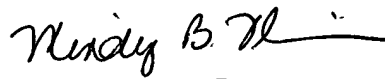
conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mindy Fleisher, Ph.D., can be reached at (703) 308-0407.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

John S. Brusca, Ph.D.

Examiner


MINDY FLEISHER
SUPERVISORY PATENT EXAMINER
GROUP 1800